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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,656	06/29/2001	Alan C. Berkema	10016784-1	9732

7590 06/28/2006  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

POLTORAK, PIOTR

ART UNIT PAPER NUMBER

2134

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/897,656

Applicant(s)

BERKEMA ET AL.

Examiner

Peter Poltorak

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,5,9-12,15,18-20,22,32-34 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-5, 9-12, 15, 18-20, 22, 32-34 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. In view of applicant remarks in the Appeal Brief filed on 04/17/2006,

PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. Claims 4-5, 9-12, 15, 18-20, 22, 32-34 and 37-39 have been examined.

***Double Patenting***

Claims 4-5, 9, 15, 18-19-20, 22 and 33 of this application conflict with claims 6 and 31 of Application No. 09/897697. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 4-5, 15, 18-19-20, 22 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 31 of copending Application No. 09/897697. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set of claims are directed towards the "print by reference", wherein the print request initiated by a wireless device is sent to a print device that retrieves and prints the print content.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

4. "The responsive signal" in claim 15 lacks antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Larsson et al. (International Publication No. WO 0142894).

Larson discloses a portable wireless device (Larson, object 100), comprising a processor (Larson, Fig. 6 object 114), a first communication interface (Larson, Fig. 6 object 118) adapted to enable communication between the portable wireless device and a print service (Larson, Object 200b comprising object 210) and a second communication interface (Larson, Fig. 6 object 116) adapted to enable wireless communication between the portable wireless device and a print device (Larson, object 380 comprising object 300) (Larson, Fig. 1, pg. 12 line 30 - pg. 13 line 6).

Larson discloses communicating using the first communication interface a reference that identifies the location of a print content to the print service (Larson, pg. 21 lines 4-6), wherein communicating the reference to the print service causes the print service to retrieve and format the print content for printing and further causes the print service using the second communication interface to transmit the print content to the portable wireless device (Larson, col. 14 lines 5-24 and pg. 21 lines 12-27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-5, 9-12, 15, 18-20 and 22, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Larsson et al. (International Publication No. WO 0142894).

As per claims 4, 9-12, 15, 18-20, 22 and 32-34 DeBry discloses communicating a reference to a print device (print server 30), the reference (a will-call certificate) identifying a location at which a print content (requested document to be printed) is located on a network and the location of a print service (a document source 10), wherein the reference causes the print device to retrieve the print content from the network and to print the print content (Fig. 2 and 3, col. 5 lines 5-7, col. 6 lines 55-64, col. 7 lines 20-51 and col. 8 lines 6-36).

DeBry teaches discloses communicating a security access code (a digital signature) to the print device wherein the access code enables access to the print content (col. 7 line 15 – col. 8 line 36).

DeBry's invention aims to ensure that only authorized access to the print content results in the content being sent to the printer for the printing (DeBry, col. 5 lines 11-19). Thus, the access code inherently enables the specific usage of the print device: printing of the requested document.

Additionally, DeBry discloses a security access code (encrypted message) in response to a security challenge received from the print device used to restrict access to the print device (Fig. 4 and col. 9 lines 5-27).

DeBry does not specifically disclose a portable wireless device, the print device responding to the print device status information request and the print device sending a response signal identifying one or more of the print capabilities of the print device.

Larsson teaches a similar system to that of DeBry, wherein a portable wireless device sends a document address to the printer and then the printer retrieves the document from a document server (Fig. 1, pg. 12 lines 25-29, pg. 13 lines 15-37 and pg. 14 lines 5-11).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to extend DeBry invention by incorporating a portable wireless device as taught by Larsson given the benefit of allowing mobile printing (Larsson, Abstract). Also, both of the disclosed systems are printing systems with clients, print content and printers and both are concerned with printing documents that are at a remote location (Larsson, pg. 2 lines 16-18 and pg. 4 lines 20-35). In both systems the request to retrieve content is directed to the printer that retrieves the content from an indicated remote location. Also, the device 100 of Larsson can be a cell phone, PDA type device, or even a small computing device (Larsson, pg. 7 lines 25-27), any of which could perform the generic functions of generic client disclosed by DeBry.

Thus, the advantages of the systems of Larsson and DeBry could have been easily combinable with more than reasonable expectations of success.

In Larsson's invention the print device responds to the print device status information request (Larsson, pg. 20 lines 26-36) and sends a response signal identifying one or more of the print capabilities of the print device (Larsson, pg. 14 lines 1-3 and 21 lines 1-6).

7. As per claims 4 and 20 DeBry discloses the need for ability to control the number of copies being distributed, e.g., to protect copyright in the document and/or payment of a fee on a per-copy basis (col. 4 line 67 – col. 5 line 2) that results in a user paying a fee for the right of printing the print content (col. 7 lines 7-13).

Furthermore, DeBry discloses the reference data comprises a serial number for tracking purposes (Fig. 2 and col. 7 lines 30-35).

As a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a serial number as billing information given the benefit of uniquely identifying a transaction and enabling appropriate charge for the printed content.

8. As per claim 5 DeBry does not explicitly disclose that the print service is adapted to format the retrieved print content for printing.

Larsson discloses the print service adapted to format the retrieved print content for printing (e.g. 16 line col. 17 line 21).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to adapt the print service to format the retrieved print content for printing as



disclosed by Larsson. One of ordinary skill in the art would have been motivated to adapt the print service to format the retrieved print content for printing in order to convert the document to a print file suitable for the printer especially in light of DeBry's disclosure of a printable copy of a document format been different from the format of a nonprintable version (col. 10 lines 45-48).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Iwata (U.S Patent 6778289),

Thambidurai, Deppa and Nakano, "Internet Printing", OKI Technical Review Vol. 64, August 1998,


Wright, "Internet Printing Design Goals", RFC 2567, April 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

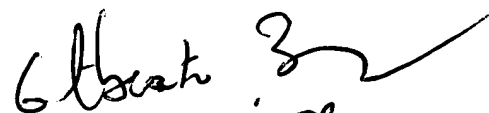
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached on (571)272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
6/26/06

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100